



Docket No. 1293.1090/MDS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Kyung-Geun LEE

Group Art Unit: 2651

Serial No.: 09/499,031

Examiner: N. Hindi

Filed: February 7, 2000

For: RECORDING MEDIUM HAVING WOBBLED GROOVE TRACKS OUT
PHASE WITH WOBBLED LAND TRACKS, SERVO CONTROLLING
APPARATUS USING WOBBLE SIGNAL AND METHOD THEREOF

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RESPONSE TO RESTRICTION REQUIREMENT

Honorable Commissioner of
Patents & Trademarks
Washington, D.C. 20231

Sir:

This is in response to the Office Action mailed February 21, 2001, having a period for response set to expire on March 21, 2001. A Petition for a One-Month Extension of Time is filed concurrently, together with the requisite fee, thus extending the period for response to April 21, 2001.

The following amendments and remarks are respectfully submitted.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect **Group I, claims 1, 7, 9-14, 19-20, 25, 31, 33, 35-38 and 45-48** in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Group II is concerned, it is believed that unelected claims 2-6, 8, 15-18, 21-24, 26-30, 32, 34, 39-44 and 49-54 drawn to FIGS. 5-6B are so closely related to the elected claims of Group I drawn to FIG. 3 that they should remain in the same application to preserve unity of the invention and to avoid any possibility of a double patenting issue arising at some later date. The elected claims of Group I are directed to a recording medium, servo controller and servo controlling method relating to phases of wobbles of land and groove tracks and the claims of Group II are drawn to a recording medium, servo controller and servo controlling method relating to phases of wobbles of land and groove tracks. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing both method and product claims in the same field of technology. The Examiner has not identified different classifications for the product two groups of claims, and in any event, it is believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II claims by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (P) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)-§806.04(i), §808.01(a) and §808.02). This section of the MPEP also states that for purposes of the initial requirement, a serious burden on the Examiner may be prima facie shown if the Examiner shows by appropriate explanation either separate

classification, separate status in the art, or a different field of search as defined in MPEP §808.02. The Examiner has not set forth any of these criteria or any other criteria for establishing that there would be a serious burden if restriction is required.

At page 2, second paragraph of the Office Action, the Examiner asserts that no claim is considered generic. However, the Applicants respectfully assert that claims 1, 7, 9, 11, 13, 19, 25, 31, 33, 35-38, 45-47, and 48 are generic as they cover both the embodiments disclosed in FIGS. 3 and 5 through 6B. Accordingly, upon the allowance of any of these generic claims, the Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of the generic claims.

In the Examiner's restriction requirement, it would appear that the Examiner has not reviewed in-depth the subject matter of the present invention. The Examiner will clearly notice upon review of all the claims, that there would be no undue burden on him to provide a search of both the Group I and Group II claims. Based upon the Examiner's standard in this application, any time any application recites different embodiments, there would be a restriction requirement for each embodiment. Such is not and cannot be the standard for making a restriction requirement in the USPTO.

Even if the Examiner considers the Group I claims to be a separate invention from the Group II claims, the Applicants respectfully request the Examiner to consider the Group I and Group II claims.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the unelected Group II claims are directed to a recording medium, servo controller and servo controlling method relating to phases of wobbles of land and groove tracks, and the elected Group I claims are directed to a recording medium, servo controller and servo controlling method relating to phases of wobbles of land and groove tracks, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,

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